

REMARKS

I. Notice of Non-Compliant Amendment

In a Notice of Non-Compliant Amendment mailed April 29, 2009, the Office stated that Applicants' Reply to Office Action, filed April 13, 2009, was non-compliant because a complete listing of the claims was not present. Applicant understands that the Office is objecting to not specifying the status of claims 1-29, which had been cancelled September 26, 2006. Accordingly, the status of cancelled claims 1-29 has been added to the above-amended claims list.

II. Status of Claims

Claims 30-58 are pending. Claims 30-54 stand rejected.

Since Claims 55 to 58 have not been rejected, Applicant understands these claims to be deemed allowable. Accordingly, if the Examiner issues a new rejection of these claims, the next office action would necessarily be non-final.

Claims 1 and 54 have been amended to remove a redundant limitation. Applicant submits the amended claims have Section 112 support in the as-filed specification. Since Applicant has amended claims 30 and 54 to remove a redundant limitation, such an amendment cannot be a basis for the next rejection being final.

III. Section 103 Rejections

In the Office Action mailed January 14, 2009, the Office rejects claims 30-54 under 35 U.S.C. § 103(a) as allegedly "being unpatentable" over EP 0 953 628 A1 to

Zucchelli et al. ("Zucchelli")¹ in view of U.S. patent 4,314,887 to Haley et al. ("Haley"), for the reasons provided at pages 2-5 of the Office Action. Applicant respectfully disagrees and traverses for the reasons set forth below.

With respect to obviousness, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

The Examiner asserted that, "Zucchelli discloses a process and a plant for producing a refuse derived solid fuel and feeding said fuel to a combustion plant...providing a first component USW...at least one second component ...selected from elastomeric material and a thermoplastic material, or mixtures thereof." Office Action at 2. The Examiner admits that, "Zucchelli does not disclose separately feeding

¹ To the extent there is any difference between EP 0 953 628 A1 and EP 0 953 628 B1, Applicants assume the Examiner is relying upon EP 0 953 628 A1 since EP 0 953 628 B1 was published after Applicant's filing date.

said first component USW and ... second component....”*Id.* The Examiner further asserts that, “It would be obvious for a person of ordinary skill in the art at the time the invention was made to provide such metering and feeding devices on a conveyor to Zucchelli in view of Haley so as to get overlapping layers... and retain its properties in the combined mixed layer at the end.” *Id.* at 3.

Applicant submits that Zucchelli, whether alone or in combination with Haley, does not teach each and every limitation. As explained in the specification, and as claimed, Applicant discovered that traditional premixing of a shredded dry fraction of solid urban waste with a shredded elastomeric and/or thermoplastic material followed by storage yields negative consequences. In particular, the resultant composition tends to agglomerate, requiring complex, expensive mixing machinery to be used prior to delivery to the plant. Zucchelli, whether alone or in combination with Haley, merely discloses this prior art scenario and not the claimed invention. See Figures 7-9, which disclose the use of storage device followed by complex mixing machinery.

First, there is no disclosure of “separately metering and feeding said first component and said at least one second component onto a continuous conveyor,” even if we accept the Examiner’s argument that there is some motivation to add Haley’s conveyor (and Applicant does not concede this point). In the claims, the first and second component are in shredded form, whereas Zucchelli teaches that the components have been ground. As evidenced by Zucchelli’s express disclosure of both forms, one skilled in the art would know the difference between a ground composition and a shredded composition.

Second, Zucchelli teaches to mix the ground compositions, and not to generate overlapping layers of shredded compositions. Contrary to the Examiner's assertion, Haley does not disclose overlapping layers but rather teaches to form adjacent, alternating rows deposited side by side on a moving chain grate. See Haley at abstract and col. 2, lines 36-40. As noted by Applicant, the overlapping layers helps avoid the agglomeration that results from pre-mixing the components. See specification at p.3. Moreover, the overlapping layers permit additional advantages, including improved mixing *after* delivery. See e.g., id. at p. 12, lines 9-15 & 23-27. Accordingly, the combination of Zucchelli and Haley does not result in the subject matter presently claimed.

Third, the claimed invention is nonobvious because the Examiner's proposed modification of Zucchelli by Haley would render Zucchelli unsatisfactory for its intended purpose. M.P.E.P. § 2143.01. Zucchelli's composition is ground while the current disclosure composition is shredded. See Zucchelli at ¶¶ [0019]-[0023] and application at p. 8, lines 1-4, p. 9, lines 23-27, p. 10, lines 17-23, & p. 11, lines 14-17. The composition of Zucchelli requires the composition to be ground after shredding in order to be operable. The grounding step allows the Zucchelli composition to be instantaneously combustible. Eliminating the grounding step and limiting the composition to a shredded composition, as in the present disclosure, would render Zucchelli unsatisfactory for its intended purpose.

For the foregoing reasons, Applicant submits that the Office's 35 U.S.C. § 103(a) rejection of independent claims 30 and 54 should be withdrawn. Because claims 31-53

and 55-58 depend from claim 1 and 54, the present rejection should be withdrawn for these claims as well.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.


If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, she is respectfully invited to contact Applicant's undersigned counsel at (202) 408-4275.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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